

REMARKS/ARGUMENTS

This amendment is in response to a Final Office Action dated July 31, 2003. After reviewing this Response, if the Examiner feels that the application is still not in condition for allowance, Applicant's request that the Examiner call Applicant's undersigned representative Michael Straub at 732-542-9070 to discuss the case. It is hoped that agreement on an amendment can be reached that will place the application in condition for Allowance.

I. Introduction

Claims 1-9 and 18-21 are pending. Claims 1-5, 7-9 and 18-19 have been rejected under 35 U.S. C. §102(e) as being anticipated by U.S. Patent No. 6,215,858 to Bartholomew et al. In addition, claims 6 and 20-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bartholomew et al. in view of U.S. Patent No. 6,374,102 to Brachman et al.

Claims 6 and 20 have been amended so that they are now in independent form. As will be discussed below, the Bartholomew et al. patent is not available to be used under 35 U.S.C. §103 and therefore claims 6, 20 and 21 are clearly patentable. In addition, it is respectfully submitted that the Bartholomew et al. patent does not anticipate any of the pending claims and is not available under §103. Thus, all the claims are patentable over applied references.

B

II. The Pending Claims are Patentable**1. The Bartholomew et al. Patent Is Not Available as Prior Art Under 35 U.S.C. §103**

Subject matter which would otherwise be prior art under 35 U.S.C. §103 via 35 U.S.C. §102(e) is disqualified as prior art against the claimed invention when the subject matter in the §102(e) reference and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." (See MPEP §706.02(1)(1)).

MPEP §706.02(1)(2) goes on to state:

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organization(s):

... if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Attached hereto as Appendix A, on a separate sheet, is the required statement regarding ownership needed to remove the Bartholomew et al. patent as a valid reference under 35 U.S.C. §103. The statement is signed by Michael P. Straub, (Reg. 36, 941) an Attorney of Record.



2. Claims 6, 20 and 21 Are Patentable

Claims 6 and 20 have been rewritten in independent form so that they do not depend from any claims rejected under 35 U.S.C. §102(e).

Claims 6, 20 and 21 were rejected under 35 U.S.C. §103 using the Bartholomew et al. patent as the principle reference. Given that this reference has been removed as an applicable §103 reference by submission of the ownership statement in Appendix A. It is respectfully submitted that Claims 6, 20 and 21 are now patentable.

In view of the ownership statement attached hereto which removes the Bartholomew et al. patent from being used under §103, it is respectfully submitted that claims 6 and 20-21 are now allowable.

3. Claims 1-5, 7-9 and 18-19 Are Also Patentable

The Examiner rejected claims 1-5, 7-9 and 18-19 under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent No. 6,215,858 to Bartholomew et al. In rejecting the claims, the Examiner states:

Claim 1-5, 7-9, 18-19 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent No. 6,215,858 (Bartholomew et al.).

Note Figs. 5 and 6 and Col. 15, line 1-Col. 16, line 57, Col. 17, lines 13-62, Col. 18, line 40-Col. 19, line 54 and Col. 20, line 61-Col. 22, line 14. ...

The MPEP §706.02(a) makes the distinction between when a rejection should be made under 35 U.S.C. §102 and §103 it states:

... for anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims.

...

As will be discussed below, modifications are required to disclosure of the Bartholomew et al. to fully meet the claims. While such modifications may seem minor to the Examiner, they are sufficient to make the reference insufficient to support a 35 U.S.C. §102 rejection.

1. Claim 1 is Patentable

Claim 1 is patentable because it recites:

A method of providing a call forwarding and a voice mail service, comprising:
storing, in a call processing record accessible by a service control point, information on the amount of time a telephone is allowed to ring before an unanswered call to the telephone is forwarded;
storing, in said call processing record, a telephone number to which the unanswered call is to be forwarded, said telephone number

corresponding to one of a telephone and
a voice mail system;
and

modifying said stored
information on the amount of time a
telephone is allowed to ring based on
information received by said voice mail
system; and

forwarding a call to said
telephone after the telephone rings for
said amount of time.

Applicants note that claim 1 requires that
modification of ring count information be based on
information received by the recited voice mail system.
Notably, however the forwarding of the call recited in
the claim, which occurs after the amount of time a
telephone is allowed to ring as determined by the ring
count information received by the voice mail system is to
a TELEPHONE NOT to the voice mail system.

Thus, in claim 1, the voice mail system serves to
control the ring time associated with a call forwarding
operation to a TELEPHONE which is different from the
Voice Mail system. Such a feature is not disclosed or
inherently present in the Bartholomew et al. patent.
Applicants do not dispute that the Bartholomew system
could be modified to support such functionality.
However, the fact that such modification is required
means that a §102 rejection is improper.

In the applied reference the Voice Mail system is
used to control ring time before forwarding to the Voice
Mail System NOT a TELEPHONE which is different from the
voice mail system. Col. 16 of the reference, which is

relied upon by the Examiner to reject claim 1 makes this clear.

Col. 16 of the Bartholomew et al. patent indicates that the voice mail system described therein controls the ring count used to control forwarding **to the voice mail system**. Col. 16 states:

... the voice mail system 120, or other centralized messaging system, will further comprise a ring count change interface 151. The interface 151 connects to ... a multi-services platform (MSP) 153. ... **The instructions from the MSP 153 will identify a specific subscriber's line and will specify a ring count or ringing interval for use in determining when a call for that subscriber has gone unanswered and should be forwarded to the voice mail system 120.** The multi-services platform may also forward instructions to change other parameters of the call forwarding function. (See col. 16, lines 1-49)

There is no teaching or suggestion of using the voice mail system to adjust the ring count used to forward calls to a telephone and in fact the claimed step is not disclosed in the reference. Accordingly, the 102(e) rejection is improper. Whether claim 1 is obvious in view of the applied reference is another matter entirely. However, we need not address that possibility since the Bartholomew et al. **is not available as a reference under 35 U.S.C. §103.**

If the Examiner persists in rejecting claim 1 as being anticipated by the Bartholomew et al. patent **it is respectfully requested that the Examiner cite where in the Bartholomew et al. patent forwarding a call to a**



TELEPHONE as a function of ring count information set by a Voice Mail system is described.

2. Claim 2 is Patentable

Applicants note that claim 2 depends from claim 1 and is therefore allowable for the same reasons that claim 1 is allowable. However, claim 2 is also patentable because the Bartholomew et al. fails to anticipate the subject matter of claim 2.

In rejecting claims to the Examiner states:

With respect to claim 2, note IPs 535 and 537. Note also, Col. 35, line 7-Col. 37, line 4. In addition, note example 1 Col 37-Col-38.

Claim 2 recites:

The method of claim 1, wherein said voice mail system is separate from an interactive peripheral device through which call forwarding service information can be updated by a telephone call to said interactive peripheral device, said method further comprising:

modifying said stored information on the amount of time a telephone is allowed to ring based on information received by said interactive peripheral device as part of a telephone call.

Applicants note that claim 2 adds to the features recited in claim 1 the feature that the voice mail system is separate from an interactive peripheral device and proceeds to recite the step of modifying the stored information on the amount of time a telephone is allowed

to ring based on information received by the interactive peripheral device. Thus, in claim 2, the ring count information which was previously modified based on information received from the voice mail system is modified based on information received from a separate peripheral device. The mere presence of two peripheral devices in the applied reference does not disclose or in any way anticipate this combination of steps. Forwarding a voice message from a peripheral device through a mail system also fails to anticipate the claimed subject matter.

Applicants respectfully submit that using an IP in combination with a Voice Mail system to send a voice mail message as described in the portion of the reference cited by the Examiner in know way anticipates the ring count modification method and particular steps recited in claim 2.

Notably, the embodiments shown in Figs. 10-13 cited by the Examiner to reject claim 2 do NOT discuss ring count modification via a peripheral device. Furthermore, Example 1, which relates to Fig. 13, that was cited by the Examiner deals with sending a voice message via a peripheral device to the voice mail system for delivery. It does not describe altering ring count information.

Col. 37, lines 51-60 which are cited by the Examiner to reject claim 2 state:

In the case where the caller indicates
a desire to send a voice message for voice



delivery, the Direct Talk server 1203A and IP communication sever 1213 in response to these instructions *direct the voice mail server 1209 to handle the message.* This voice mail sever may be of the type described in detail in connection with the previously discussed embodiment of the invention and the voice mail system illustrated in FIG. 5. ... Following the caller pressing the "send" key, *as directed in the voice prompt interchange, the message is transferred* from the voice mail server 1209 to the Internet interface 1237 ...

In view of the above, it is respectfully submitted that the anticipation rejection of claim 2 and the claims which depend there from should be withdrawn.

If the Examiner persists in the rejection of claim 2 it is respectfully requested that the Examiner explicitly identify where in the prior art the reference describes ring count information changed by a Voice Mail that is used to control call forwarding to a telephone is changed based on information provided in a telephone call to a peripheral device which is separate from the voice mail system.

3. Claim 18 is Patentable

Claim 18 is patentable for the same general reasons claim 2 is patentable. Claim 18 provides two alternative devices for updating the same information regarding the amount of time a phone is allowed to ring before a call is forwarded, e.g., a Voice mail system and a separate peripheral device. As discussed above, the Bartholomew



et al. does not describe such a system and therefore the anticipation rejection of claims 18 and 19 should be withdrawn. Furthermore, since the Bartholomew et al. patent can not be used to support an obviousness rejection, claims 18 and 19 are clearly allowable.

Accordingly, claim 18 is patentable because it recites:

A telephone system capable of forwarding a call directed to a telephone, comprising:

a service control point including information on the amount of time said telephone should be allowed to ring before forwarding a call directed to said telephone to another destination;

a telephone switch coupled to said control point and to said telephone for detecting the amount of time said telephone rings and for forwarding calls;

an interactive peripheral device coupled to said telephone switch for receiving calls used to control call forwarding operations, said interactive peripheral device including means for receiving information via a telephone call and means for updating said information on the amount of time a telephone should be allowed to ring as a function of information received via a telephone call; and

a voice mail system coupled to said service control point, said voice mail system including means for updating said information on the amount of time a telephone should be allowed to ring as a function of information received by said voice mail system via a telephone call.

Conclusion

The pending claims are not anticipated by the Bartholomew et al. patent for the reasons discussed with regard to the independent claims. Furthermore, in view of the ownership statement attached hereto, the Bartholomew et al. patent can not be used to support an obviousness rejection. Accordingly, all of the outstanding rejections have been overcome and the application is now in condition for allowance. Such allowance is respectfully requested.

Respectfully submitted,
Michael B. Straub Reg. No. 36,941 for

October 31, 2003

Loren Swingle, Esq.

Loren Swingle, Attorney
Reg. No. 32,764
(914) 644-2366

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patents and Trademark Office on the date shown below.

Michael P. Straub

Type or print name of person signing certification

Michael B. Straub
Signature

October 31, 2003
Date

Appendix

Statement of Ownership At Time of Invention

The undersigned, who is an attorney of record,
hereby states:

The present application, S.N. 09/608,393 and U.S.
Patent No 6,215,858 were owned by, or subject to, an
obligation of assignment to the same organization, at the
time the invention claimed in the present application was
made.



Michael P. Straub
Reg. No. 36,941

The above language is consistent with that suggested
in MPEP 706.02(1)(2) to overcome the use of a 35 U.S.C.
§102(e) reference under 35 U.S.C. §103.

